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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,336	01/14/2004	Joseph G. Renter	K47.12-0001	3462
27367	7590	04/15/2005	EXAMINER	
WESTMAN CHAMPLIN & KELLY, P.A. SUITE 1600 - INTERNATIONAL CENTRE 900 SECOND AVENUE SOUTH MINNEAPOLIS, MN 55402-3319			REESE, DAVID C	
			ART UNIT	PAPER NUMBER
			3677	

DATE MAILED: 04/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/757,336

Applicant(s)

RENTER, JOSEPH G.

Examiner

David C. Reese

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7 and 11-14 is/are rejected.
- 7) ☒ Claim(s) 4-6 and 8-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

[1] Claims 1-14 are pending.

Drawings

[2] The drawings are objected to because: Corrected drawings may be necessary to comply with the specification objection regarding label 30. Please see below. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

[3] The disclosure is objected to because of the following informalities: On page 4, line 17, “point 11.A post 28 with...” should be “point 11. A post 28 with...”.

Also, in the same line, “near end 30 does not seem to match up correctly with the submitted diagrams, as it appears as if 30 in Figs. 1 and 2 is part of the intermediary connecting member, not “a near end 30 attached to the conical point 22.”

Appropriate correction is required.

Claim Rejections - 35 USC § 102

[4] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[5] Claims 1, 3, 11 are rejected under 35 U.S.C. 102(b) as clearly anticipated by King, Jr., US- 3,443,398, because the invention was patented or described in a printed publication in this or

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a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

As for Claim 1, King, Jr. teaches of a stud type earring for adorning an ear, comprising:

a conically-shaped stud mounting extending conically outward from a conical point to form a conical basket (10) for securing a stone therein (12), a post with a near end (14) attached to the conical point and a far end (14a), and a nut engagable with the far end of the post for securing the stud mounting to the ear (22);

a dangling element for suspension below the stud mounting (32); and

an intermediary connecting member (27) which removably engages an exterior surface of the conical basket (10), and which includes a jump ring (28) extending outward therefrom for flexibly supporting the dangling element (32) so that the dangling element (32) is removably suspendable below the stud mounting (10).

Re: Claim 3, wherein the dangling element (32) has a wire attachment extending therefrom (34), and wherein the jump ring (28) engages the wire attachment (34).

As for Claim 11, King, Jr. teaches of a method for adorning an ear with stud type earring comprising the steps of:

providing a conically-shaped stud mounting extending conically outward from a conical point to form a conical basket (10) for securing a stone therein (12), a post with a near end (14) attached to the conical point and a far end (14a), and a nut engagable with the far end of the post for securing the stud mounting to the ear (22);

a dangling element for suspension below the stud mounting (32); the dangle element (32) being attached to an intermediary connecting member (27) which removably engages an exterior surface of the conical basket (10);

engaging the intermediary connecting member (27) over the post so as to frictionally engage the conical basket (10 in Fig. 1), so that the dangling element (32) is removably positioned below and adjacent the stud mounting (10);

inserting the post (14a) into the ear (16); and

securing the nut (20) to the post to secure the stud mounting to the ear (Fig. 2).

Claim Rejections - 35 USC § 103

[6] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[7] Claims 2, 7, 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over King, Jr., US- 3,443,398, in view of Simpson, US-6,508,081.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

King, Jr. teaches of the above claims.

However, King, Jr. fails to disclose expressly of the specific stud mounting design including at least two wires (up to four) forming the conical basket, a wire seat attached to an inner surface of the conical basket and to which the stone is secured.

Simpson teaches of an earring with interchangeable ornaments, wherein such earring contains a stud mounting exact in structure to that of applicant; that is, the stud mounting includes at least two wires (up to four) forming the conical basket, a wire seat attached to an inner surface of the conical basket and to which the stone is secured.

At the time of invention, it would have been obvious to one of ordinary skill in the art to modify the stud mounting as taught by King, Jr., to incorporate the various wire structures as taught by Simpson, in order to as Simpson states in column 4, line 9, "that allows the wearer to selectively interchange ornaments and that improves the visual appearance of the earring and ornament while reducing the wearer's discomfort."

In addition, this method of attaching a gemstone is merely an example of design choice, as it would have been an obvious matter of design choice to create a stud mounting as shown, as Applicant has not disclosed that it solves any stated problem of the prior art or is for any particular purpose. Furthermore, this particular type of stud mounting is extremely well known (Pejchar, 758,848; Shechter, 5,638,700; Epstein, D264,060; Luthy, 398,787; Hartmann, 292,810; and Yerushalmi, US 2004/0083758) to those skilled in the art for both aesthetic and functionality purposes.

Thus, as for Claim 2, wherein the stud mounting (Fig. 3 of Simpson) has at least two wires forming the conical basket (9), wherein the intermediary connecting member (27 of King,

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Jr.) removably engages all the wires forming the conical basket (Fig. 3 of Simpson), and wherein the intermediary connecting member (27 of King Jr.) is disposed behind the stud mounting (Fig. 2 in King, Jr.).

Re: Claim 7, wherein stud mounting further includes a wire seat (15 of Simpson) attached to an inner surface of the conical basket (Fig. 3 of Simpson) and to which the stone is secured (Fig. 3 of Simpson).

As for Claim 11, King, Jr. teaches of a stud type earring for adorning an ear, comprising: a stud mounting having a stone (Fig. 3 of Simpson), a bezel wire for securing the stone (7, 15 of Simpson), a support wire attached to the bezel wire (11 of Simpson), a post with a near end (11 of Simpson) attached to the support wire and a far end (13 of Simpson), and a nut engagable with the far end of the post for securing the stud mounting to the ear (20 of King, Jr.);

a dangling element (32 of King, Jr.) having a wire attachment extending therefrom (28 of King, Jr.); and

a removable intermediary connecting member (27 of King, Jr.) which removably engages an exterior surface of the support wire (11 of Simpson), and which includes a jump ring extending (28 of King, Jr.) outward therefrom for flexibly supporting the wire attachment (34 of King, Jr.) of the dangling element (32 of King, Jr.).

Re: Claim 12, wherein the intermediary connecting member (27) has a notch (26) formed therein at all points where the intermediary connecting member engages the support wire (Figs. 1 and 2 of King, Jr.).

Re: Claim 13, wherein the intermediary connecting member has a beveled area formed therein so that the intermediary connecting member does not engage the stone when the jewelry design is worn (Fig. 2 of King, Jr.).

Allowable Subject Matter

[8] Claims 4-6, 8-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As for Claims 4-6, 8-10, the prior art, incorporating other corresponding limitations as set forth above, does not teach of the specific structure of intermediary connecting member possessing a number of legs and notches forming various shapes, respective to that of the number of wires forming the conical basket of the stud mounting of the instant invention, allowing said legs and notches to then engage a respective one of the said wires forming the conical basket.

Conclusion

[9] The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited further to show the state of the art with respect to this particular type of earring; as well as their extreme relevance to the current application as many read extensively onto the claimed invention: please see adjoining reference cited.


[10] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is ~~555-555-5555~~ **see below**. Due to a future move, however, this number will change after the 31st of March. After this date, the

examiner can be reached at (571) 272- 7082. The examiner can normally be reached on 7:30 am - 5:00 pm M-Th, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (703) 306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,
David Reese
Examiner
Art Unit 3677


ROBERT J. SANDY
PRIMARY EXAMINER